IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application:

Application. No.:	10/692,569	Confirmation No.: 9107
Applicants:	Judith D. Auslander, et al.	
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Art Unit:	2876	
Examiner:	Nguyen, Kimberly D	
Attorney Docket No.:	F-736	
Customer No.:	00919	Date: January 19, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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Sir:

This communication is submitted in response to the August 21, 2006 Final Office Action ("Final Office Action"). Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. A Notice of Appeal is filed concurrently herewith. The review is requested for the reason(s) stated on the following attached sheet(s). Consideration of the enclosed remarks is respectfully requested.

The following attached sheets are enclosed:

1. Statement in Support of Pre-Appeal Brief Request For Review

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at 571-273-8300, on January 19, 2007 (Date of Transmission).

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(Signature) January 19, 2007 (Date)

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STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 11-12, 14, 16-17, 19-20 and 22-23 stand rejected under 35 USC 103(a) as being unpatentable over Wright et al. (US 4,864,618) in view of Bhatt. Bipin G (EP 900830). Reconsideration is respectfully requested.

As stated in the Background of the Invention section of the specification of the instant application, a black color is preferably used for printing two dimensional bar codes and is the preferred color for optimal contrast and readability. One problem with the printing of black two dimensional bar codes is that they can lead to easy duplication by available desktop printers or copiers. The black prints can easily be copied by any black-and-white copier or scanned and reprinted easily by available printers. Another problem is that everyone can see what is printed in the bar code. In some applications it is desirable to pass some information covertly for security reasons. The instant application addresses a desire to hide information in a printed indicium, such as a two dimensional bar code, but which hideen information can be relatively easily verified or read. The instant application also addresses a desire to provide hidden information which can be used to provide an additional level of security, such as with postage indicia.

The issues present in the above rejection are straight forward. Independent claim 19 is a method of printing an indicium on an item. Claim 19 comprises:

> printing a first pattern on the item with a first non-fluorescent ink, the first ink having a first color under normal daylight; and
>
> printing a second pattern on the item at the first pattern **with a second different ink, wherein the second different ink comprises a fluorescent ink having a substantially same color as the first ink under normal daylight, wherein the first and second patterns are substantially visually indiscernible within the indicium under normal daylight, and wherein the second pattern is discernible from the first pattern when subjected to a fluorescent-exciting illumination source.**

Independent claim 11 is a system for printing an indicium on an item. Claim 11 comprises:

> print head system comprising a first supply of a first ink having a first color under normal daylight and a second supply of a second different ink, **the second different ink having a second color under a normal daylight which is substantially the same as the first color, and wherein the second ink comprises a fluorescent ink;**

> a controller for controlling application of the first and second inks by the print head system on the item, wherein the **controller is adapted to print the first and second inks in at least partially intermixed patterns such that the patterns of the first and second inks are substantially visually indiscernible within the indicium in normal daylight, and the second pattern of the second ink is discernible from the first pattern when subjected to fluorescent-exciting radiation**.

The Examiner has based her rejection primarily on Wright et al. The Examiner has found that Wright et al. teach all the elements of claims 11 and 19 except for the fluorescence of the second ink. The Examiner relies on the Bhatt reference for the purpose of teaching that an invisible ink is a fluorescent ink.

The instant invention has nothing to do with invisible ink. Neither Wright et al. nor Bhatt, alone or in combination, teach or suggest the instant invention. In fact, Wright et al. teach against the instant invention because Wright et al. teach a printing system that comprises a second ink that is invisible ink, and not, as in the instant invention, an ink having a second color under a normal daylight which is substantially the same as the first color.

The instant invention discloses a two ink supply printing system which has the capability of hiding information in a printed indicium based on the characteristics of the two inks (substantially the same color but one is a fluorescent ink) and the two respective patterns printed with the two inks. The information is hidden in the indicium because, since the indicium is printed with the two inks that are substantially the same color, the first and second patterns are substantially visually indiscernible within the indicium under normal daylight. However, the pattern printed with the fluorescent ink is discernible from the first pattern when subjected to a fluorescent-exciting illumination source. The instant invention discloses a corresponding method of printing indicium. Thus, the instant invention produces images such as shown in Figs. 1-6 and Figs. 9-13 of the instant application. **Wright et al. does not disclose or suggest a system or method that produces such images.**

Wright et al., on the other hand, disclose a printing system that could use a single visible ink (col. 12, line 55-58) but, preferably, uses a second ink which is invisible in the normal light spectrum to hide the authentication information. See col. 12, lines 48-58. The printing system of Wright et al. produces images such as shown in Fig. 6a of Wright et al. where code 78 is the "hidden" information and the rest of the image is visible in normal light. Wright et al. does not disclose a

printing system that prints first and second patterns, wherein the first and second patterns are substantially visually indiscernible within the indicium under normal daylight, and wherein the second pattern is discernible from the first pattern when subjected to a fluorescent-exciting illumination source. Code 78, when printed with invisible fluorescent ink is not discernible at all. When code 78 is printed with the single visible ink, code 78 is clearly discernible from the rest of the printed image. See Applicants Response dated June 5, 2005, at pages 4-5.

In the Final Office Action mailed August 21, 2006, the Examiner argues beginning at the bottom of page 3 that it would be obvious for Wright et al. to use an alternative second ink as required by the instant invention instead of the invisible ink disclosed by Wright et al. However, Wright et al. already discloses an alternative to the invisible ink. As stated above, Wright et al. disclose a printing system that could use a single visible ink (col. 12, line 55-58), to print the entire image in Fig. 6a. There is not suggestion in Wright et al. to combine the properties of the two inks disclosed in Wright et al., i.e., the color of the visible with the magnetic, infrared, or ultraviolet properties of the invisible ink. Furthermore, Wright et al. does not disclose or suggest a printing system that could produce the images as produced by the instant invention can (Figs. 1-6 and Figs. 9-13 of the instant application). Applicants respectfully submit that the Examiner's argument is impermissible hindsight to suggest that one of skill in the art would consider replacing the invisible ink disclosed in Wright et al. with the second ink in the instant invention. See Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561 (Fed. Cir. 1987).

> To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

At page 4 of the Final Office Action, the Examiner argues that

> While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 143 1-32 (Fed. Cir. 1997).

Applicants submit that independent claim 11 is a system claim that differs structurally from Wright et al. in that Wright et al. does not disclose or suggest the print head system or the controller as in claim 11. Specifically, the print head system structural difference is that the print head system of the instant invention comprises a first supply of a first ink having a first color

under normal daylight and a second supply of a second different ink, the second different ink having a second color under a normal daylight which is substantially the same as the first color. The controller structural difference is that the controller of the instant invention controls the application of the first and second inks by the print head system on the item, wherein the controller is adapted to print the first and second inks in at least partially intermixed patterns such that the patterns of the first and second inks are substantially visually indiscernible within the indicium in normal daylight. Furthermore, this argument by the Examiner i.e., structural vs. functional, has no merit with regard to independent claim 19.

See Applicants Response dated June 5, 2005, at pages 5 and 6, for remarks concerning the dependent claims. Since the rejections of the dependent claims are based on the foregoing rejection of the independent claims, for the foregoing reasons the dependent claims are allowable.

In summary, for at least the above reasons, Appellant respectfully submits that the rejections as to claims 11 and 19 are in error and should be reversed. Claims 12-18 and 20-23 are dependent upon claims 11 and 19 respectively and therefore the rejections with respect to these claims should also be reversed.

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims of this application are now in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,

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